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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,818	08/29/2001	Olivier Guiter	PALM-3693	8438

7590 10/18/2004

WAGNER, MURABITO & HAO LLP  
Third Floor  
Two North Market Street  
San Jose, CA 95113

EXAMINER
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BELL, PAUL A

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/942,818

Applicant(s)

GUITER ET AL.

Examiner

PAUL A BELL

Art Unit

2675

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/24/2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4,5,7,19-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4,5,7,19-22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4, 5, 7, 19, 20, 21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber et al. (6,418,325) in view of Pallakoff (US 2002/0151283 A1 pub 10/17/2002).

With regard to claim 4 Reber et al. teaches a method for displaying information (figure 4 items 44 and 10) comprising: displaying information in a display screen region of a hand held device in an area identified by permanent printing (SEE Reber figure 2, items 26 and 30 "permanent image" reads on permanent printing, column 3, lines 30-37, 55-62, column 4, lines 16-21 "liquid crystal display" note how in figure 4 you see the numbers and then in figure 5 they are no longer displayed), wherein said hand held device comprises a main display screen region distinct from said display screen region (figure 4, item 44), said main display screen region free of any area of permanent printing (figure 4, item 44), wherein said display screen region is implemented using a first display screen unit (figure 4, item 10), and said main display screen region is implemented using a second display screen unit (figure 4, item 44).

Reber et al. does not directly illustrate a mere "use" recitation, of which his device is capable of doing, such as "turning off said second display screen unit and displaying said information on said first display screen unit".

Art Unit: 2675

However, Pallakoff also shows a hand held electronic device having at least two displays the main or second display being of high resolution and the first display being of low resolution the user has the option of viewing a large image on the high resolution display or a subset of the large image on the low resolution display (SEE Pallakoff abstract and figure 5, items 500 and 501 and section [0011] ) and further Pallakoff teaches turning off second display when using first display (SEE Pallakoff section [0015]) .

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Reber et al. phone so that his second display is of high resolution and the first display is low resolution whereby the "user" can "turn off said second display screen unit and display said information on said first display screen unit" as taught by Pallakoff because he teaches this saves power (SEE Pallakoff section [0015]).

With regard to claim 5 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 5 in addition the applicant is now claiming, "displaying said information on said first display screen unit automatically in response to a signal for turning off said second display screen unit" .

(SEE Pallakoff abstract; "When a user is viewing a Web page (or other content) on a device's micro display held near-to-eye, the device allows the user to position a cursor or a rectangular outline (or some other indication of a "**region of interest**") on a particular part of the Web page, and then **when the user moves**

Art Unit: 2675

the device out to arms'-length viewing, the user should be able to view that region of interest on the direct-view display--that is, view a subset of the larger image that appeared on the micro display" also see section [0015] "In addition, when the user is not holding the device near-to-eye, the micro display can be turned off or idled, saving power--so devices that use this invention can use significantly less power than devices that leave micro displays on continuously." It is clear that applicants claimed recitations above are merely directed towards an obvious intended "use" of the Reber/Pallakoff combination where the user looks in the micro display focuses on a particular information or region on that display hits a button that causes a signal to automatically turn off that display and then holds the device at arms length and sees that the particular information is automatically displayed on the direct view display. The examiner simply can not see any novel distinction in this broadly written claim in view of what the combination of Reber/Pallakoff structure which was obviously capable of being used that way).

With regard to claim 7 the combination of Reber et al. and Pallakoff was found above in claims 4 and 5 to already read on most of the limitations of claim 7 in addition the applicant is now claiming, "a clock display" is the type of said information sent (SEE Pallakoff see Figure 6 which shows "clock information" such as "2:20pm" was sent).

With regard to claim 19 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 19 in addition the applicant is now claiming, "a hand held computer system" (SEE Reber et al. figure 1, item 16) and further "wherein said first display screen unit is configured to remain operational when said second display unit is turned off" (SEE Pallakoff section [0015]).

With regard to claim 20 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 20 in addition the applicant is now claiming, "wherein said first display screen unit is configured to turn on automatically in response to a signal turning off said second display screen unit" which is also taught by Pallakoff see section [0015] also see rejection of 1 and 5 above.

With regard to claim 21 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 21 in addition the applicant is now claiming, "wherein said first display screen unit is specialized for a clock display" (SEE Pallakoff see Figure 6 which shows "clock information" such as "2:20pm" and since it displays clock information one of ordinary skill in the art would of put forth the statement that the device was at least specialized and displaying clock information).

With regard to claim 24 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 24 where the "displaying information" and "response to a signal" claimed above also reads on "secondary information" and "response to an event" in addition the applicant is now claiming, "wherein said displaying secondary information does not interfere with said displaying program information on said main display screen region" and wherein said event is an

Art Unit: 2675

incoming phone call and wherein said secondary information is a dialog enabling the receipt of said phone call (SEE Pallakoff figure 5 items 500-503 and figure 6 items 604 and 600 wherein figures 5 and 6 clearly illustrate this feature wherein the incoming call does not interfere with the main program and SEE Reber et al figure 2, item 72 and figure 4, item 116 column 8, line 24, "to answer an incoming telephone call").

With regard to claim 25 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 25 where in addition the applicant is now claiming, "wherein said event is the receipt of a short message and wherein said secondary information is the body of said short message" (SEE Pallakoff illustrates this in figure 6 items 600 and SEE Reber figure 4).

With regard to claim 26 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 26 and in addition the applicant is now claiming, "wherein said secondary information is clock display information" (SEE Pallakoff figure 6).

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination Reber et al. (6,418,325) and Pallakoff (US 2002/0151283 A1 pub 10/17/2002) in view of Horie et al. (US 20020058529 A1 pub 5/16/2002).

With regard to claim 22 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 22 in addition the applicant is now claiming, "a protective display cover" See Reber et al. where figure 4 item 104 pivot point for cover and section [0009] [0010].



The combination of Reber et al. and Pallakoff does not illustrate "said protective display cover comprising at least one non-opaque region for viewing said first display region through said nonopaque region when said display cover is covering the display".

However Horie et al. teaches a protective display cover comprising at least one non-opaque region for viewing display region through said nonopaque region when said display cover is covering the display (figure 3, items 3 and 12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reber et al./Pallakoff display cover to be like Horie et al. because he teaches it's the preferred type cover because you can protect most of the display and still see a part of it SEE section [0010].

4. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination Reber et al. (6,418,325) and Pallakoff (US 2002/0151283 A1 pub 10/17/2002) in view of Lui et al. (6,552,719)

With regard to claim 27 the combination of Reber et al. and Pallakoff was found above to already read on most of the limitations of claim 27 and in addition the applicant is now claiming, "wherein said event is a program event requiring a user to enter alphanumeric data into said program and wherein said secondary information is a keyboard image" of which the combination of Reber al./Pallakoff does not illustrate.

However Lui et al. teaches a system and method for automatically switching between writing and text input modes in figures 5 item 52 "keyboard icon" to figure 6 item 50 a actual usable touch image of a keyboard.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Reber et al./Pallakoff display to have a

Art Unit: 2675

keyboard option as taught by Lui et al. because by not having hard keys it frees up more room for a larger display which is much more desirable.

***Response to Arguments***

Applicant's arguments filed 6/24/2004 have been fully considered but they are not persuasive.

With regard to claims 4, 5, 7, 19-22 and 24-27 applicant on pages 3 and 4 argues that Reber does not teach, suggest or disclose; "first and second display screen units" because applicant alleges item 10 is only a "touch-pad" and not; "a display screen region...identified by permanent printing".

The examiner disagrees because Reber teaches that item 10 is both a display and a touch-pad and this display has permanent images (or printing) and examiner references the more detailed rejection above.

With regard to claim 5 applicant on page 5 argues that Reber nor Pallakoff does not teach, suggest or disclose, "displaying said information on said first display screen unit automatically in response to a signal for turning off said second display screen unit".

The examiner disagrees with this broadly claimed "automatic feature " because Reber illustrates a combination of automatic and manual features and examiner reference the more detailed rejection above. And further it has been found in the courts that the mere act of making any well known manual procedure automatic and broadly claiming it to be "automatic" would be an obvious desirable improvement. The applicant must argue and have claimed specific novel details of structure of how it was made automatic that would not have been obvious and view of the prior art manual method.

Art Unit: 2675

With regard to claim 7 applicant on pages 5 and 6 argues that Reber nor Pallakoff does not teach, suggest or disclose, "sending information for a clock display to said first display screen unit automatically in response to a signal for turning off said second display screen". Further note applicant renders a narrow interpretation of his claim when he argued "current clock information" (not in the claim).

The examiner disagrees with this feature of a specific type of information being clock display in view of the rejection of claims 1 and 5 and examiner reference the more detailed rejection above of claim 7.

With regard to claims 19 and 20 applicant argues on pages 6 and 7 arguments which were already addressed above and examiner references claim rejections.

With regard to claim 24 applicant on page 8 argues that Reber nor Pallakoff does not teach, suggest or disclose, "display screen region identified by permanent printing".

The examiner disagrees with this and reference the more detailed rejection above of claim 24 and especially claims 4 and 5.

With further regard to claim 24 applicant argues on page 8 that Reber nor Pallakoff does not teach, suggest or disclose, "displaying secondary information on a second display screen (responsive to) an incoming phone call and wherein said secondary information is a dialog enabling the receipt of said phone call". Note this is not the exact language of claim but does represent a sufficient summarization.

The examiner disagrees and references the more detailed rejection above of claim 24.

With regard to claim 25 applicant on pages 8 and 9 argues that Reber nor Pallakoff does not teach, suggest or disclose, "wherein the event and secondary information is a short message".

The examiner disagrees with this and reference the more detailed rejection above of claim 25 .

With regard to claim 22 on pages 9 and 10 the arguments were already addressed.

With regard to claim 27 applicant on page 10 argues that Reber / Pallakoff /Pallakoff does not teach, suggest or disclose, "in response to an event , displaying secondary information on a second display wherein said secondary information is a keyboard image" because he argues Lui teaches away .

The examiner disagrees with this and reference the more detailed rejection above of claim 27 . Lui is not the primary reference therefore it is proper to pick any feature off of Lui and add it to the primary reference when examiner demonstrates sufficient motivation to do so and so long as the change does not teach away from the main objective of the primary reference.

#### Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

Art Unit: 2675

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Bell whose telephone number is (703) 306-3019.

If attempts to reach the examiner by telephone are unsuccessful the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377 can help with any inquiry of a general nature or relating to the status of this application.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231


Or Faxed to: (703) 872-9306

Or Hand-delivered to: Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor  
(Receptionist)

  
Paul Bell

Art unit 2675

October 16, 2004

  
CHANH NGUYEN  
PRIMARY EXAMINER